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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,383	09/30/2003	Harold Fisher	3589.68503	6841

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EXAMINER

DOSTER GREENE, DINNATIA JO

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/675,383

Applicant(s)

FISHER, HAROLD

Examiner

Dinnatia Doster-Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Detail Action</u> . |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed December 16, 2005 have been fully considered but they are not persuasive for the reasons discussed below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16-17 and 19-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Starrett et al. (U. S. Patent No. 3,888,482). Starrett discloses a thumb splint comprising a first loop (19) wherein a loop attachment accommodates a user's thumb and a second loop (20) having a loop attachment to accommodate a user's index finger (Figs. 2-5). The first loop attachment is located outside of the second loop. Starrett further discloses a strap (22) having sufficient length to diagonally cross a user's palm (Figs. 2, 3, and 5).

Claims 16-18, 20, 21, 27, 30, 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Lanz (AT No. 401,868). Regarding claims 16 and 21, Lanz discloses a thumb splint for limiting angular motion of a thumb, formed from a single elongate strap of non-elastic material having a first surface and a second surface, said thumb splint comprising: a first loop (1) formed at a first end of said strap, by folding said end of strap onto said strap, parallel thereto, and affixing said end thereto, said first

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loop being dimensioned to accommodate a user's thumb, near the base thereof; a second loop (2) formed in said strap a predetermined distance from said first loop, by folding said strap substantially transversely over and onto itself and affixing said strap to itself at the point of intersection, said second loop being dimensioned to accommodate a user's index finger; and a positioning means (Figs. 2-3) between said first loop and said second loop to hold said first loop near the base of said user's thumb and said second loop to said user's index finger.

Regarding claim 17, Lanz discloses in Figs. 2-3 wherein said positioning means comprises an elongate portion of said strap extending from said second loop, of a length sufficient to diagonally cross a user's palm and wrap around a user's wrist.

Regarding claim 18, Lanz also discloses wherein said thumb splint is worn in conjunction with a glove, and said positioning component comprises webbing of said glove, wherein said webbing is located between a thumb and finger receiving portion of said glove (Lanz, page 4 and claim 7).

Regarding claims 20, 23, Lanz discloses wherein said thumb splint prevents said thumb moving away from said index finger beyond 100° to a position where a wearer could injure the thumb (Lanz, page 1).

Claims 24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Furr (U. S. Patent No. 5,188,356). Furr discloses a device comprising a thumb stabilizing component (Fig. 6), an index finger receiving section (31), a non-extendable flexible connector extending between the thumb section and index finger, an elongated

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strap formed from a single strip of webbing extending over a palm, wrist and back of a hand (Figs. 5-7) and velcro strips affixed to the elongated strap.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 19, 22, 25 and 28-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lanz in view of Furr. As discussed above, Lanz discloses the claimed but fails to teach the specific materials recited and specifically teach the band of material is provided with releasable securing means to secure the band of material around a person's wrist. However, Furr, which also relates to a thumb splint, teaches that it is known to releasably secure the band about the user's wrist. Thus, it would

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have been obvious to one skilled in the art at the time of the invention to incorporate the releasable securing means of Furr into the thumb splint of Lanz in order to facilitate the ease of removing the splint. Furthermore, the choice of material is considered a matter of obvious design choice within the knowledge of the skilled artisan as one with ordinary skill in the art would select a material based upon its suitability for the intended use.

Claims 18 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Starrett in view of Lanz. As discussed above, Starrett discloses the claimed but fails to teach a thumb splint in combination with a glove or mitt. However, Lanz, which also relates to a thumb splint or sporting equipment device, teaches that it is known to include incorporate such a device into a glove or mitt. Thus, it would have been obvious to one skilled in the art at the time of the invention to incorporate the glove or mitt of Lanz into the device of preventing injury during sporting activities.

Double Patenting

Claims 24 and 25 are rejected under the judicially created doctrine of double patenting over claims 1-2 of U. S. Patent No. 6,783,507 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming

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common subject matter, as follows: an index finger receiving section, a non-extendable flexible connector and a thumb receiving section.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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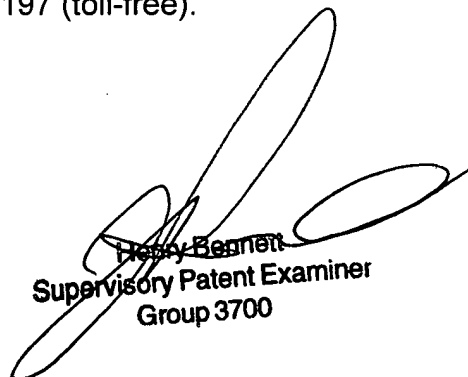
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dinnatia Doster-Greene whose telephone number is 571-272-7143. The examiner can normally be reached on 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ddg



Henry Bennett
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Group 3700